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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/047,262 | 01/15/2002 | Ronald A. Holland | C43770/126119 | 4517 |

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|---|---|
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| ART UNIT | PAPER NUMBER |
|---|---|
| 3618 | |

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/047,262 | HOLLAND, RONALD A. | |
| | Examiner | Art Unit | |
| | Christopher Bottorff | 3618 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *16 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-4,8-11,15-18,22-25 and 29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,8-11,15-18,22-25,29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

The amendment filed January 16, 2004 has been entered. Claims 5-7, 12-14, 19-21, 26-28, and 209 are canceled. As noted by Applicant, claims 8-11 are directed to the elected invention. Claims 1-4, 8-11, 15-18, 22-25, and 29 are pending and have been considered on the merits.

### *Claim Objections*

Claim 15 objected to because of the following informalities: Line 13 of claim 15 recites the term "wit" before "the skating surface." This appears to be a misspelling of the term "with." Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 8 defines an incline of approximately twenty-five degrees rearward from vertical. Lines 4 and 5 of paragraph 22 of the specification indicate that variations in the

inclination are possible. However, the specification does not disclose a specific inclination of approximately twenty-five degrees.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson US 5,924,704 in view of Moore US 5,873,583 and Riutta US 5,192,099.

Johnson discloses an in-line roller skate having a boot 5, a frame secured to the boot and formed by the base of the boot shell and bracket 4, a plurality of skating wheels 1 and 3 rotatably mounted on the frame, a counter-rotatable braking device 6 rotatably attached to the frame, and a braking wheel 2 rotatably attached to the frame. The braking device includes means 38, 39 to allow rotation of the device in one direction and to resist rotation in the other direction. The braking wheel is attached to the frame by a mechanism for slidably attaching an axle to the frame that allows displacement of the axle in an upward direction. This mechanism comprises a pair of parallel elongated slots in the frame, which accommodate insert 23, with an axle slidably mounted in the slots on which the braking wheel 2 is mounted. In addition, the braking device is approximately in line with the axes of the slots.

The contact point between the braking wheel and the braking device is approximately vertically above the contact point between the braking wheel and the skating surface when the skating wheel adjacent to the braking wheel and the braking wheel are both in contact with the skating surface. The braking device is oriented to allow rotation of the braking wheel against the skating surface in the forward skating direction and to resist rotation of the braking wheel against the skating surface in the reverse direction. Also, the counter-rotatable breaking device, the breaking wheel and the skating wheels are in a common plane of rotation. See Figures 2 and 6A-6C; column 3, lines 34-39; and column 4, lines 1-39.

Johnson discloses the braking device and braking wheel at the rear end of the frame, rather than the claimed forward end. However, Moore teaches that the practice of arranging a braking device 33 and braking wheel 32 at the forward end of a skate frame was old and well known in the art at the time the invention was made. See Figures 1-3. From the teachings of Moore, arranging the braking device, braking wheel, and slots of Johnson at the forward end of the frame, rather than the rear end, would have been obvious to one of ordinary skill in the art at the time the invention was made. This would assist the operator in starting and accelerating. Furthermore, this would dispose the skating wheels rearward of the slot.

Also, Johnson does not disclose that the long axes of the slots are inclined rearward approximately ten degrees from vertical. However, Riutta teaches the old and well known practice of arranging slots 56 on a skate frame at a rearward incline. See Figure 4 and also see slot 38 in Figure 5. From the teaching of Riutta, arranging the

slots of Johnson at a rearward incline would have been obvious to one of ordinary skill in the art at the time the invention was made. This would improve the efficiency of the brake device of Johnson by maintaining more direct alignment between the sliding motion of the braking wheel and the braking device when the skate is oriented at an angle during a forward skating motion. This modification would necessarily result in the braking device of Johnson being approximately in line with the axes of the slots and would allow the axis of the braking wheel to displace in a direction approximately in line with the axis of the braking device, such that the braking wheel may displace in an upward direction inclined rearward from vertical and contacts the braking device.

Moreover, the depiction of slots 56 and 38 in Figures 4 and 5 of Riutta suggest that the slots are oriented approximately ten degrees from vertical. From this teaching of Riutta, orienting the slots of Johnson approximately ten degrees from vertical would have been obvious so that the incline of the slots would be oriented for optimum efficiency when the skate is at an angle during a forward skating motion. Also, the claimed range of approximately ten degrees does not distinguish over the prior art because the claimed range and the range of Riutta overlap, or at least are close enough that one of ordinary skill in the art would have expected them to have the same properties. See *Titanium Metals Corp. of America v. Banner*, 227 USPQ 773 (Fed. Cir. 1985).

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 8-11, 15-18, 22-25, and 29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/192,947 in view of Riutta US 5,192,099.

Claims 1-4, 8-11, 15-18, 22-25, and 29 differ from claims 1-8 of Application 10/192,947 by reciting limitations that define the performance of the braking wheel relative to the braking device. In particular, claims 1-4, 8-11, 15-18, 22-25, and 29 define displacement of the braking wheel in a direction approximately in line with the axis of the braking device and the contact point between the braking wheel and the braking device being approximately vertically above the contact point between the braking wheel and the skating surface.

However, Riutta teaches that arranging a braking wheel and brake device such that the braking wheel is displaced in a direction approximately in line with the axis of the braking device and the contact point between the braking wheel and the braking device is approximately vertically above the contact point between the braking wheel

and the skating surface. From the teachings of Riutta, arranging the claimed front wheel and brake member defined in claims 1-8 of Application 10/192,947 such that the front wheel is displaced in a direction approximately in line with the axis of the brake member and the contact point between the front wheel and the brake member is approximately vertically above the contact point between the front wheel and the skating surface

This is a provisional obviousness-type double patenting rejection.

***Response to Arguments***

Applicant's arguments filed January 16, 2004 have been fully considered but they are not persuasive.

The arguments focus on Johnson alone, rather than the combination of Johnson with Moore and Riutta. However, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Since the above rejection is based on the combination of references, the arguments directed to Johnson alone are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the use of a braking device having a coefficient of friction with the braking wheel that is less than the coefficient of friction between the braking wheel and the skating surface, locating the braking device above the wheels, antilock braking, and allowing all

of the vertical force from the skater's weight on the skating surface to be transferred through the braking wheel to the braking device) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, contrary to Applicant's assertions on page 8 of the remarks, braking wheel 2 of Johnson is mounted to allow free displacement of its axle as force applied by the skater causes wheel 2 to act upon elastomeric insert 23 and move upward. Although this displacement is not exactly in line with the axis of the braking device, the displacement is "approximately" in line with the axis of the braking device. Such alignment will be closer to exactly in line in the apparatus resulting from the combination of the teachings of Johnson, Moore, and Riutta. Also, the point of contact between the braking wheel and the braking device occurs at a point vertically above the contact point between the braking wheel and the skating surface. This is evident in Figure 2 of Johnson.

In regard to the application of the teachings of Johnson to the front wheels, Applicant's assertion that skidding will result is speculation. The teachings of Johnson, Moore, and Ruitta do not suggest such skidding will occur from their combination.

### *Conclusion*

Due to the new terms of rejection applied to claims 8-11 and the introduction of the double patenting rejection above, this office action is NOT final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (703) 308-2183. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Bottorff

BRIAN L. JOHNSON
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3/30/04